

O-321-19

**TRADE MARKS ACT 1994
IN THE MATTER OF APPLICATION No. 3278429
BY ASTUTE SAFETY SOLUTIONS LIMITED
TO REGISTER THE TRADE MARK**

ULTIM8

IN CLASSES 6, 9, 19, 35 & 37

AND

**IN THE MATTER OF OPPOSITION
THERETO UNDER No. 412789 BY
TARMAC HOLDINGS LIMITED**

BACKGROUND

1) On 20 December 2017, Astute Safety Solutions Limited (hereinafter the applicant) applied to register the trade mark ULTIM8 in respect of the following goods and services:

In Class 6: Rings of metal (devices of personal protection); buckles of metal (devices of personal protection); hooks of metal (devices of personal protection); cables of metal non-electric; safety chains of metal; chains of metal (devices of personal protection); spring hooks of metal (devices of personal protection); scaffolding apparatus (Metal -); safety scaffolding of metal; safety chains of metal; building materials and building elements; pipes and tubes; steel wire; tool clips; ladders; posts; fences; grab rails; parts and fittings for all the aforesaid goods.

In Class 9: Safety tarpaulins; safety harnesses (other than for sport equipment); safety leg-loop harnesses (other than for sport equipment); protective helmets; life belts, anti-fall belts, with or without fall shock-absorber, safety belts; devices for personal protection against accidents; safety climbing-down devices; rescue devices; workmen's protective face-shields; nets for protection against accidents, fall arrest safety nets, safety nets; gloves for protection against accidents; anti-fall harnesses, safety restraints; protective glasses, non-dazzle glasses and eyeshades, protective masks, workmen's protective masks; fall-arrest safety mobile tripods; clothing for protection, clothing for protection against accidents, irradiation and fire; face masks; safety boots; helmets; safety clothing; safety harnesses; respirators; fire blankets; fire extinguishers; site communicators; parts and fittings for all the aforesaid goods.


In Class 19: Scaffolding equipment, not of metal; barrier apparatus; safety barriers of plastics material; safety panels of plastics material; roof coverings, not of metal.

In Class 35: Services of retailing in relation to safety equipment for construction and construction workers, protective equipment, scaffolding equipment.

In Class 37: Building construction; scaffolding services; scaffolding hire; scaffolding repair; scaffolding construction; installation of temporary barriers; advice services relating to construction and construction safety.

2) The application was examined and accepted, and subsequently published for opposition purposes on 16 March 2018 in Trade Marks Journal No.2018/011.

3) On 15 June 2018 Tarmac Holdings Limited (hereinafter the opponent) filed a notice of opposition. The opponent is the proprietor of the following registration:

Mark	Number	Dates of filing and registration	Class	Specification relied upon
 <p>A series of three trade marks</p>	UK 3022456	17.09.13 24.01.14	19	Asphalt surfacing materials; aggregates; materials for maintenance and repair of roads, paths, car parks, driveways, cycle tracks, pedestrian areas, sports areas and playgrounds.
			35	Retail and wholesale services connected with the sale of building materials for use in repair, surfacing and maintenance for civil engineering, infrastructure and construction; assistance and consultancy relating to business management and organisation; arranging for the provision of building and construction goods and

				services; management services for construction supply of infrastructure, industrial, commercial, public sector and residential buildings.
			37	Repair services for industrial buildings, residential buildings, roads, paths, car parks, driveways, cycle tracks, pedestrian areas, sports areas and playgrounds; surfacing and maintenance for civil engineering, infrastructure and construction.

4) The ground of opposition is, in summary:

- a) The opponent contends that the mark applied for and its marks are similar and that its services in class 37 are highly similar or identical to the applicant's goods in classes 6 & 9 and the services in class 37; that the opponent's goods in class 19 are identical or highly similar to the applicant's goods in class 19; that the opponent's services in class 35 are identical or highly similar to the applicant's class 35 services. As such it contends that the application offends against Section 5(2)(b) of the Act.

5) On 2 August 2018 the applicant filed a counterstatement which denies that there is a likelihood of confusion.

6) The applicant filed a witness statement from its Trade Mark Attorney, Ms Forsyth. However, this was in fact submissions regarding the similarity of the marks, and the goods and services

of both parties. Effectively neither side filed evidence. Both parties seek an award of costs in their favour. Neither side wished to be heard; both sides filed written submissions which will be referred to as and when necessary.

DECISION

7) The sole ground of opposition is under section 5(2)(b) which reads:

“5.-(2) A trade mark shall not be registered if because -

(a)

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

8) An “earlier trade mark” is defined in section 6, the relevant part of which states:

“6.-(1) In this Act an "earlier trade mark" means -

(a) a registered trade mark, international trade mark (UK) or Community trade mark which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks.”

9) The mark relied upon by the opponent is clearly an earlier trade mark.

10) When considering the issue under section 5(2)(b) I take into account the following principles which are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

The average consumer and the nature of the purchasing decision

11) As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods and services. I must then determine the manner in which these goods and services are likely to be selected by the average consumer in the course of trade. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and

reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

12) The goods and services concerned are, broadly speaking, connected with building and construction. They will be purchased by the general public and businesses. The choice will probably be made by viewing a physical or on-line catalogue, or in person by viewing the items on the shelves of a DIY outlet or builders merchants. The choice will be primarily visual although I accept that both the general public and professionals may seek advice from the staff and so aural considerations must also play a part. The applicant contends that all the goods and services are associated with safety in the construction industry and consequently the relevant purchasers are building industry professionals concerned with health and safety and would choose goods and services with care and attention. Whilst I accept that many of the goods and services are related to safety there are a number of general construction goods and services such as, inter alia, “building materials; pipes; tool clips; ladders” in class 6; “site communicators” in class 9; “roof covering” in class 19; “services of retailing in relation to scaffolding equipment” in class 35; and “scaffolding hire” in class 37 that have nothing to do with safety. I also note that a number of items such as, inter alia, ladders, protective glasses, face masks and roof coverings that would be purchased by the general public engaged in DIY projects, similarly they may hire scaffolding and employ a company engaged in building construction. The opponent’s view is far too narrow. Whilst clearly a number of the goods and services will be purchased by professionals, including sole traders, not all are that well versed in health and safety issues or indeed, from my experience, overly concerned with such issues. The consumers will range from industry professionals to the general public and **the attention given even by the average member of the public to the purchase of such goods and services will only be an average degree.** I am willing to accept that larger professional companies are likely to take slightly more care in making decisions regarding the purchase of goods and services as their survival may depend upon making the correct choice both economically and for the image of the business. **To my mind, the average business**

consumer for these types of goods is likely to pay at least a medium degree of attention to the selection of items of such goods and services.

Comparison of goods and services

13) In the judgment of the Court of Justice of the European Union (CJEU) in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary”.

14) In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court (GC) stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM- Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

15) In *YouView TV Ltd v Total Ltd* ,[2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

"... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of 'dessert

sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question."

16) In *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another*, [2000] F.S.R. 267 (HC), Neuberger J. (as he then was) stated that:

"I should add that I see no reason to give the word "cosmetics" and "toilet preparations"... anything other than their natural meaning, subject, of course, to the normal and necessary principle that the words must be construed by reference to their context."

17) In *Avnet Incorporated v Isoact Limited*, [1998] F.S.R. 16, Jacob J. (as he then was) stated that:

"In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase."

18) In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the GC stated that "complementary" means:

"...there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking".

19) In *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. *chicken* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL-0-255-13:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes.”

Whilst on the other hand:

“.....it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.”

20) I also note that if the similarity between the goods/services is not self-evident, it may be necessary to adduce evidence of similarity even if the marks are identical. In *Commercy AG, v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-316/07, the GC pointed out that:

“43. Consequently, for the purposes of applying Article 8(1)(b) of Regulation No 40/94, it is still necessary, even where the two marks are identical, to adduce evidence of similarity between the goods or services covered by them (see, to that effect, order of 9 March 2007 in Case C-196/06 P *Alecansan v OHIM*, not published in the ECR, paragraph 24; and Case T-150/04 *Mülhens v OHIM – Minoronzoni(TOSCA BLU)* [2007] ECR II-2353, paragraph 27).”

21) Thus, where the similarity between the respective goods or services is not self-evident, the opponent must show how, and in which respects, they are similar.

22) I shall first compare the applicant's goods in classes 6 and 9 to the opponent's services in class 37, which the opponent maintains are similar. For ease of reference the goods and services of each party are shown below.

<p>Applicant's Class 6: Rings of metal (devices of personal protection); buckles of metal (devices of personal protection); hooks of metal (devices of personal protection); cables of metal non-electric; safety chains of metal; chains of metal (devices of personal protection); spring hooks of metal (devices of personal protection); scaffolding apparatus (Metal -); safety scaffolding of metal; safety chains of metal; building materials and building elements; pipes and tubes; steel wire; tool clips; ladders; posts; fences; grab rails; parts and fittings for all the aforesaid goods.</p> <p>Class 9: Safety tarpaulins; safety harnesses (other than for sport equipment); safety leg-loop harnesses (other than for sport equipment); protective helmets; life belts, anti-fall belts, with or without fall shock-absorber, safety belts; devices for personal protection against accidents; safety climbing-down devices; rescue devices; workmen's protective face-shields; nets for protection against accidents, fall arrest safety nets, safety nets; gloves for protection against accidents; anti-fall harnesses, safety restraints; protective glasses, non-dazzle glasses and eyeshades, protective masks, workmen's protective masks; fall-arrest safety mobile tripods; clothing for protection, clothing for protection against accidents, irradiation and fire; face masks; safety boots; helmets; safety clothing; safety harnesses; respirators; fire blankets; fire extinguishers; site communicators; parts and fittings for all the aforesaid goods.</p>	<p>Opponent's Class 37: Repair services for industrial buildings, residential buildings, roads, paths, car parks, driveways, cycle tracks, pedestrian areas, sports areas and playgrounds; surfacing and maintenance for civil engineering, infrastructure and construction.</p>
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23) The applicant contends there is no similarity between its goods and the opponent's services. For its part the opponent merely states that the applicant's goods as listed in classes 6 and 9 are "incidental to and/or required for the construction and repair services specified in class 37 of the registration". The opponent also referred me to four cases. The UKIPO case (O-471-18) involved a concession of behalf of the applicant which meant that the matter was not ruled upon and so this does not assist my decision. The other three cases are from the EUIPO (two EUIPO Board of appeal cases (Case R 2050/2011-2 WINDOWSTAR and Case R1052 /2010-1 EIFFEL), and one opposition case (EUTM opposition B00184055 VENTUS). I note that the decisions imply that the same undertakings produce the parts used in building work. This suggests that some evidence to this effect must have been filed in these cases, or that the goods and services were somewhat removed from those in the instant case. I have included the parts of the decisions referred to by the opponent at annex 1. To my mind, these decisions were referring to items which were used as part of the building such as windows etc. Most of the items in the applicant's specification are items which would be used by the workmen and then taken away with them at the end of the building work. Therefore, I find that the following items in classes 6 & 9 are not similar to the services of the opponent.

Class 6: Rings of metal (devices of personal protection); buckles of metal (devices of personal protection); hooks of metal (devices of personal protection); cables of metal non-electric; safety chains of metal; chains of metal (devices of personal protection); spring hooks of metal (devices of personal protection); scaffolding apparatus (Metal -); safety scaffolding of metal; safety chains of metal; steel wire; tool clips; ladders; parts and fittings for all the aforesaid goods.

Class 9: Safety tarpaulins; safety harnesses (other than for sport equipment); safety leg-loop harnesses (other than for sport equipment); protective helmets; life belts, anti-fall belts, with or without fall shock-absorber, safety belts; devices for personal protection against accidents; safety climbing-down devices; rescue devices; workmen's protective face-shields; nets for protection against accidents, fall arrest safety nets, safety nets; gloves for protection against accidents; anti-fall harnesses, safety restraints; protective glasses, non-dazzle glasses and eyeshades, protective masks, workmen's protective masks; fall-arrest safety mobile tripods;

clothing for protection, clothing for protection against accidents, irradiation and fire; face masks; safety boots; helmets; safety clothing; safety harnesses; respirators; site communicators; parts and fittings for all the aforesaid goods.

24) This leaves the following goods which it might be reasonable for a building contractor to supply as part of the building work. In which case the user and distribution channel would be the same. The following goods are similar to the opponent's services to a low degree.

Class 6: building materials and building elements; pipes and tubes; posts; fences; grab rails; parts and fittings for all the aforesaid goods.

Class 9: fire blankets; fire extinguishers; parts and fittings for all the aforesaid goods.

25) I next turn to the applicant's goods in class 19 which the opponent contends are similar to its class 19 goods. The two parties goods are:

Applicant's class 19: Scaffolding equipment, not of metal; barrier apparatus; safety barriers of plastics material; safety panels of plastics material; roof coverings, not of metal.	Opponent's class 19: Asphalt surfacing materials; aggregates; materials for maintenance and repair of roads, paths, car parks, driveways, cycle tracks, pedestrian areas, sports areas and playgrounds.
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26) The applicant contends that its goods are specialised whereas the opponent's goods are purchased in bulk for collection by vehicles ready for laying. The opponent contends that the word "materials" is defined as being "things needed for an activity". It claims that "it follows that the goods specified in class 19 of the application, being things that are or might reasonably be needed for the maintenance and repair of, inter alia, car parks (which might be multi storey car park buildings) fall within the ordinary meaning if materials for maintenance and repair of roads, paths, car parks, driveways, cycle tracks, pedestrian areas, sports areas and playgrounds".

27) To my mind, “Scaffolding equipment, not of metal; barrier apparatus; safety barriers of plastics material; safety panels of plastics material;” are the items that one uses in order to carry out building work. They are akin to a drill or other such tools. They are not the materials actually used such as aggregates etc. to carry out the repair and which remain in situ after the work has finished. These items are not similar to the opponent’s class 19 goods. This leaves “roof coverings, not of metal”. The applicant has not clarified what this means and so I must use my own knowledge to consider it. As the opponent has set out car parks are often multi-storey affairs which usually have a lift within which requires a purpose built structure above the highest floor level in which to house the winch and cable. Such plant rooms obviously require roofs and so in maintaining or repairing a car park roofing material may be required. I therefore find that “roof coverings, not of metal” in the applicant’s class 19 specification is identical to the opponent’s class 19 goods.

28) This is not the end of class 19 as the opponent contended, in the alternative, that all of the applicant’s class 19 goods are used in relation to construction, maintenance and repair activities and might reasonably be sold through the same trade channels. These goods are clearly of a different nature, have different intended purposes and methods of use and are not in competition. The mere fact that they are also articles used in construction and have the same users, and possibly share the same trade channels, is insufficient, in my view, to create any material similarity between the goods.

29) I must also consider whether the goods of the two parties in class 19 (excluding “roof coverings, not of metal”) are complementary. To my mind, whilst the goods of the two parties may occasionally be used together one is not essential for the other and they have very different uses. The goods in class 19 of the two parties are not complementary.

30) I next turn to the services of the two parties in class 35, which are:

Applicant’s Class 35: Services of retailing in relation to safety	Opponent’s class 35: Retail and wholesale services connected with the sale of building materials for use in repair, surfacing and maintenance for civil engineering, infrastructure and
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equipment for construction and construction workers, protective equipment, scaffolding equipment.	construction; assistance and consultancy relating to business management and organisation; arranging for the provision of building and construction goods and services; management services for construction supply of infrastructure, industrial, commercial, public sector and residential buildings.
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31) The applicant contends that its services are in relation to safety equipment which it claims is a very specialised industry. However, safety equipment as has been shown earlier takes many forms from simple gloves and boots which most hardware stores supply to more specialised equipment such as respirators. To my mind, the words “arranging for the provision of building and construction goods and services” encompasses the whole of the applicant’s specification. The class 35 services are identical.

32) Lastly, I turn to the class 37 services of both parties which are:

Applicant’s class 37: Building construction; scaffolding services; scaffolding hire; scaffolding repair; scaffolding construction; installation of temporary barriers; advice services relating to construction and construction safety.	Opponent’s class 37: Repair services for industrial buildings, residential buildings, roads, paths, car parks, driveways, cycle tracks, pedestrian areas, sports areas and playgrounds; surfacing and maintenance for civil engineering, infrastructure and construction.
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33) The applicant contends that its services are in relation to building construction and safety aspects which it claims are different to the opponent’s repair services and surfacing and maintenance services. The opponent’s services cover a wide range of repair services to buildings (residential and industrial) as well as peripheral areas such as paths, roads etc. In my opinion, this is wide enough to encompass the services offered by the applicant. I include in this the advice services as one would expect a contractor to be able to advise on safety aspects commensurate with the job. A sole trader will be aware of the need to erect temporary barriers and put lights on a skip whilst projects involving multi-storey properties would usually


be undertaken by larger contractors who will employ a specialist safety adviser. The class 37 services are identical.

Comparison of trade marks

34) It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by them, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

35) It would be wrong, therefore, to artificially dissect the trade marks, although, it is necessary to take into account their distinctive and dominant components and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by them. The opponent’s registration is a series of three marks, however being a series they are virtually identical and so I have simply selected the first to be used in the comparison. The opponent cannot be better placed with either of the other two marks. The trade marks to be compared are:

Applicant’s trade mark	Opponent’s trade mark
ULTIM8	

36) The applicant contended:

“3. The Opponent's mark is for a stylised form of the word **ULTIMATE**. It is my belief that the word "ultimate" itself is entirely laudatory as it is commonly used to indicate that products are the best available, for example "these are the ultimate fixings", "the ultimate design service meeting all your needs". I therefore believe that the Opponent thus has no rights in the word "ultimate" itself but only has rights in relation to the particular stylisation of their mark.

4. The Opponent's mark **ULTIMATE** includes the visual device of a mirrored inverted letter L to represent T within "ultimate" which, in combination with the letter L, visually creates a representation of an interrupted square. In my opinion this is very different to the Applicant's mark ULTIM8 where the "ultim" part of the mark is shown as normal letters. I am of the opinion that the marks are visually dissimilar and that no purchaser of the goods and services provided by the Applicant would consider there to be any connection between the marks ULTIM8 and **UL7IMATE**

5. With regard to phonetic similarity, the Opponent does not in my view have any exclusive rights in the word "ultimate". Further, it is my view that the public would pronounce the marks differently, with the Opponent's mark being pronounced as "ultimut" and the Applicant's mark being pronounced "ultim" "8".”

37) For its part the opponent contends:

“The trade mark the subject of the Application is comprised of the letters "UL TIM" followed by the number "8" with no additional stylisation. The Opponent submits that this will be comprehended by the relevant public as an alternative form of the word "ULTIMATE" (the letter 8 commonly being used as an abbreviated form of the letters "ATE"), and not as separate word and number elements (see *SABEL BV v Puma AG* C-251/95 1}23). Accordingly, the Opponent submits that single dominant element of the trade mark the subject of the Application is the text "UL TIMS".

The trade mark the subject of the Registration is comprised of the word "UL TI MATE" with some slight stylisation in each of the series. The Opponent submits that the dominant element of the trade mark the Registration is the word element "ULTIMATE" rather than the slight element of stylisation. This is because word elements of figurative or stylised marks are more readily remembered by the relevant consumer than figurative elements. This is particularly the case here where the stylisation is relatively slight.

Visual Similarity

The first five letters of the trade mark the subject of the Application are identical to the first five letters of the trade mark the subject of the Registration. It is established case law that in words signs or signs containing a verbal element, the first part is generally the part which catches the consumer's attention (*Trubion Pharmaceuticals, Inc. v OHIM T-412/08*, r40). The Opponent therefore submits that the trade mark the subject of the Application is visually similar to the trade mark the subject of the Registration to at least an average degree.

Aural Similarity

The trade mark the subject of the Application will be understood as, and pronounced as, the word "UL TI MATE", which is identical to the word element of the trade mark the subject of the Registration. The Opponent therefore submits that the trade mark the subject of the Application is aurally identical to the trade mark the subject of the Registration.

Conceptual Similarity

The trade mark the subject of the Application will be understood as the word "UL TI MA TE". which is identical to the word element of the trade mark the subject of the

Registration. The Opponent therefore submits that the trade mark the subject of the Application is conceptually identical to the trade mark the subject of the Registration.

Overall comparison

As the trade marks are visually similar, and aurally and conceptually identical it follows that on an overall comparison the trade mark the subject of the Application is highly similar to the trade mark the subject of the Registration.”

38) The opponent’s mark is not actually the word “ultimate” but is effectively UL7IMATE where the number “7” or inverted letter “L” takes the place of the letter “T”. I fully agree with the applicant that the average consumer will view the verbalise the mark as “ultimate”, primarily because it is the easiest way of saying the mark instead of UL-seven-IM-ATE. The fact remains that the mark is on the register and as such must be deemed to have a degree of distinctiveness (*Formula One Licensing BV v OHIM*, Case C-196/11P). I also note that the applicant’s own mark is effectively the word “ULTIMATE” as well and yet it clearly believes that it can be registered.

39) The degree of stylisation in the opponent’s mark in the use of shading for the letter “L” and the figure “7” and also the fact that there is either a number “7” or an inverted “L” in the opponent’s mark will not pass unnoticed. Neither will the use of the number “8” in the applicant’s mark. However, whilst there are visual differences there are also similarities. Both marks begin with the letters “UL”. The opponent then uses the number 7 instead of the letter T but there are clear visual similarities between these characters. Both marks then have the letters “IM” but the opponent’s mark ends with the letters “ATE” whilst the applicant’s mark ends with the number “8”. To my mind, whilst there are differences visually there are also similarities which mean that the marks have at least a low to medium degree of similarity.

40) Verbally, I have already stated that I believe that both marks will be pronounced as the word ULTIMATE. Whether one pronounces this word as UL-TIM-UT or UL-TIM-ATE the individual will use the same on both marks. The marks are verbally identical or at least highly similar.

41) Turning to the conceptual comparison, to my mind both marks will be immediately viewed as referencing the word “ULTIMATE” and the laudatory meaning which is associated with the word. It will be seen as indicating that the goods or services are the best. The marks must therefore be regarded as conceptually identical.

42) Overall, I believe that the marks are similar to at least a medium to high degree.

Distinctive character of the earlier trade mark

43) In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

44) The opponent has not provided any evidence of sales for its goods or services in the UK, as such the opponent's mark **cannot benefit from enhanced distinctiveness through use**. The opponent's mark effectively consists of the word ULTIMATE where the letter "T" has been replaced by the number "7" and the letter "L" is shaded. Clearly, this can be viewed as a laudatory term, but the degree of stylisation is such that it achieved registration and so it has a degree of distinctive character (see earlier in this decision). **To my mind, the earlier mark has a low inherent distinctiveness.**

Likelihood of confusion

45) In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the opponent's trade mark as the more distinctive the trade mark is, the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods and services, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind. Earlier in this decision, I concluded that:

- the average consumer for the goods is a member of the general public including businesses who will select the goods and services by predominantly visual means, although I do not discount aural considerations and that they are likely to pay at least an average to medium degree of attention to the selection of said goods and services.
- the marks of the two parties have at least a medium to high degree of similarity.
- The opponent's mark has a low level of inherent distinctiveness and cannot benefit from an enhanced distinctiveness through use.

- the services of the two parties in classes 35 & 37 are identical.
- The applicant's goods "roof coverings, not of metal" in class 19 are identical to the opponent's goods in the same class.
- The following goods of the applicant are similar to a low degree to the opponent's services in class 35:

Class 6: building materials and building elements; pipes and tubes; posts; fences; grab rails; parts and fittings for all the aforesaid goods.

Class 9: fire blankets; fire extinguishers; parts and fittings for all the aforesaid goods.

- There is no similarity between the applicant's goods listed below and the opponent's goods and services:

Class 6: Rings of metal (devices of personal protection); buckles of metal (devices of personal protection); hooks of metal (devices of personal protection); cables of metal non-electric; safety chains of metal; chains of metal (devices of personal protection); spring hooks of metal (devices of personal protection); scaffolding apparatus (Metal -); safety scaffolding of metal; safety chains of metal; steel wire; tool clips; ladders; parts and fittings for all the aforesaid goods.

Class 9: Safety tarpaulins; safety harnesses (other than for sport equipment); safety leg-loop harnesses (other than for sport equipment); protective helmets; life belts, anti-fall belts, with or without fall shock-absorber, safety belts; devices for personal protection against accidents; safety climbing-down devices; rescue devices; workmen's protective face-shields; nets for protection against accidents, fall arrest safety nets, safety nets; gloves for protection against accidents; anti-fall harnesses, safety restraints; protective glasses, non-dazzle glasses and eyeshades, protective masks, workmen's protective masks; fall-arrest safety mobile tripods; clothing for protection, clothing for protection against accidents, irradiation and fire; face masks;

safety boots; helmets; safety clothing; safety harnesses; respirators; site communicators; parts and fittings for all the aforesaid goods.

Class 19: Scaffolding equipment, not of metal; barrier apparatus; safety barriers of plastics material; safety panels of plastics material.

46) It is necessary to consider the likelihood of both direct and indirect confusion. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10, Mr Iain Purvis Q.C. as the Appointed Person, explained that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

47) I also note that in *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, Mr James Mellor Q.C., as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls to mind another mark. This is mere association not indirect confusion.

48) Clearly, given the views expressed in *Waterford Wedgwood plc v OHIM – C-398/07 P* (CJEU) and *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, some similarity in the goods and services is required to find confusion (direct or indirect). Therefore the

opposition under section 5(2)(b) must fail in relation to those goods and services regarded as not similar in paragraph 45 above.

49) In view of all of the above and allowing for the concept of imperfect recollection, as the marks of the two parties are similar to at least a medium degree there is a likelihood of consumers being confused, directly or indirectly, into believing that the goods and services which I have found to be identical or similar to a low degree as listed in paragraph 44 above and provided by the applicant are those of the opponent or provided by an undertaking linked to it. **The opposition under Section 5(2) (b) therefore succeeds in respect of the following goods and services applied for by the applicant:**

Class 6: building materials and building elements; pipes and tubes; posts; fences; grab rails; parts and fittings for all the aforesaid goods.

Class 9: fire blankets; fire extinguishers; parts and fittings for all the aforesaid goods.

Class 19: Roof coverings, not of metal.

Class 35: Services of retailing in relation to safety equipment for construction and construction workers, protective equipment, scaffolding equipment.

Class 37: Building construction; scaffolding services; scaffolding hire; scaffolding repair; scaffolding construction; installation of temporary barriers; advice services relating to construction and construction safety.

50) The opposition under section 5(2)(b) fails in respect of the following goods and services:

Class 6: Rings of metal (devices of personal protection); buckles of metal (devices of personal protection); hooks of metal (devices of personal protection); cables of metal non-electric; safety chains of metal; chains of metal (devices of personal protection); spring hooks of metal (devices of personal protection); scaffolding

apparatus (Metal -); safety scaffolding of metal; safety chains of metal; steel wire; tool clips; ladders; parts and fittings for all the aforesaid goods.

Class 9: Safety tarpaulins; safety harnesses (other than for sport equipment); safety leg-loop harnesses (other than for sport equipment); protective helmets; life belts, anti-fall belts, with or without fall shock-absorber, safety belts; devices for personal protection against accidents; safety climbing-down devices; rescue devices; workmen's protective face-shields; nets for protection against accidents, fall arrest safety nets, safety nets; gloves for protection against accidents; anti-fall harnesses, safety restraints; protective glasses, non-dazzle glasses and eyeshades, protective masks, workmen's protective masks; fall-arrest safety mobile tripods; clothing for protection, clothing for protection against accidents, irradiation and fire; face masks; safety boots; helmets; safety clothing; safety harnesses; respirators; site communicators; parts and fittings for all the aforesaid goods.

Class 19: Scaffolding equipment, not of metal; barrier apparatus; safety barriers of plastics material; safety panels of plastics material.

CONCLUSION

51) The opponent was successful in its opposition to the application with regard to the goods and services in paragraph 49 above, but unsuccessful in respect of the goods listed at paragraph 50 above. As both sides have enjoyed a degree of success I decline to award either side costs.

Dated 6 June 2019

George W Salthouse
For the Registrar,
the Comptroller-General

Annex 1

Case R 2050 /2011-2 WINDOWSTAR: are often manufactured by the same or related undertakings and distributed via the same channels as are the earlier 'window frames of metal; shutters of metal; window fasteners of metal; windows (fittings of metal for-); parts and fittings for any of the aforesaid goods'. Thus, they are found to be similar.

The contested 'transportable buildings of metal' may consist of 'interchangeable panels of metal building-) and building (fittings of metal for-)' of the earlier mark. It is common on the market that the same or related undertakings produce these parts and fittings as well as the buildings themselves. The target consumers coincide and these goods are often sold in the same stores, where the consumers select the prefabricated buildings and/or combine the modules and parts according to their specific needs. Consequently, these goods are found to be similar.

Case R1052 /2010-1 EIFFEL

Goods in Classes 6 and 19

51 The Opposition Division's finding that the contested goods in Classes 6 and 9 were similar to the opponents' 'building contraction' services has been challenged by the applicant. It has not discussed, on the other hand, that these goods are dissimilar to the services in Class 36 and the Board confirms this conclusion.

52 Some of the contested goods designated under Class 6 belong to very specific sectors and are so specific as regards their intended purpose, quality requirements, intended use and targeted consumer that no similarity may be found with 'building construction' services. These are the goods which are dissimilar, contrary to the conclusion of the Opposition Division:

– 'containers of metal (storage, transport); metal tanks; Containers of metal for compressed gas or liquid air; containers of metal for liquid fuel', 'shims of metal; shims'; 'transport pallets of metal' in Class 6 which are primarily used for transport and storage, mainly by professionals in that sector.

– ‘advertisement columns of metal’ in Class 6.

53. For the remainder, the Board notes that the contested goods in Class 6 include mainly unwrought and partly wrought common metals as well as simple products made from them. The contested goods in Class 19 include mainly non-metallic building materials. In fact, the contested goods designated under these two classes represent various types of building materials (i.e. metallic in Class 6 and non-metallic in Class 19) and a variety of unprocessed and semi-finished products, also used primarily in connection with the construction of buildings, as defined above (para. 42). These goods are important for ‘building’ activities so that they can be considered as complementary. Besides, building services often imply the supply of the goods listed in Classes 6 and 19, by the main contractor or by one of the subcontractors. Moreover, instead of having them supplied by the provider of building services, the end consumer may decide to acquire them from another provider so that these goods and services compete with each other.

Finally, it is plausible that the distribution channels of these goods and services overlap (e.g. advertised in the same specialist printed publications), as mentioned in Communication of 31 January 2012 (see paras 43 to 44). Therefore, except as regards the goods listed above in paragraph 51, the goods designated by the contested mark in Classes 6 and 19, are similar to a low degree with ‘building construction’ services of earlier mark No 2 563 100.

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Contested goods in class 6:

The contested common metals and their alloys; metal building materials; transportable buildings of metal; materials of metal for railway tracks; non-electric cables and wires of common metal; ironmongery, small items of metal hardware; pipes and tubes of metal; safes; goods of common metal not included in other classes; ores are similar to the opponent’s *building and construction, locksmith services and mining extraction* in class 37 as they can coincide in producers, end users and distribution channels. They also can be complementary

as is the case with the contested *safes* and the the opponent's *locksmith services* because it is common in the relevant market sector for the manufacturers of these goods also to provide such services.